

Appl. No. 09/994,741  
Amdt. dated 1/9/06  
Reply to Office action of October 19, 2005

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-6 and 9-21 remain in the application and are subject to examination. Claims 1 and 6 have been amended. No claims have been canceled. Claims 10-21 have been allowed.

In "Claim Rejections - 35 USC § 112", item 2 on page 2 of the above-identified Office Action, claims 1-6 and 9 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Examiner states that in claim 1 it is not understood how Applicant is:

1. forming said looped binding element immediately before the insertion step; and
2. forming a plurality of loops in the looped binding element in a row ..., and inserting the loops into the perforations at the same time.

The Examiner also states that it is not understood how one can form a plurality of loops in already looped binding material.

The wording of claim 1 questioned by the Examiner as paraphrased in item 1 above is believed to be completely understandable. This wording states that the looped binding

Appl. No. 09/994,741  
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element 41 is formed before the step of inserting the looped binding element 41 into the perforations 12. This is not only in accordance with the disclosure of the instant application but is completely logical, in that the looped binding element must be formed before inserting the looped binding element into the perforations.

Regarding the wording of claim 1 as paraphrased in item 2 above, the Examiner's comments are well taken, in that the loops are not formed in an already looped binding element. It is not clear if the Examiner is also questioning the wording in claim 1 calling for inserting the loops in the perforations at the same time. However, it is noted that the meaning of this phrase is that all of the loops are inserted at the same time.

In order to remove any possible indefiniteness in claim 1, the claim has been amended to set forth the steps of providing the material (11) with perforations (12), determining a production parameter with the control device (110), forming a binding element (41) with loops, and subsequently inserting all of the loops of the binding element (41) into the perforations (12) at the same time.

Appl. No. 09/994,741  
Amdt. dated 1/9/06  
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More specifically, claim 1 now calls for a process for producing brochures without a supply of pre-formed looped binding elements, the process comprising the steps of:

providing a plurality of superposed sheet-like material having perforations along an edge;

determining at least one production parameter with an electronic control device;

forming a binding element by forming a plurality of loops in a row extending across a width of a brochure; and

inserting said looped binding element into said perforations immediately after producing said looped binding element by inserting all of said loops into said perforations at the same time.

Pursuant to the request by the Examiner, it is noted that support for these changes may be found in the drawings and the specification of the instant application. For example, providing the sheet-like material 11 with perforations 12 is seen in Figs. 1 and 3 and described in the last paragraph on page 3; the electronic control device 110 is seen in Fig. 1 and determining parameters therewith is described in the penultimate paragraph on page 3; the binding element 41 is seen in Fig. 3 and described in the penultimate paragraph on page 3; and the loops of the binding element 41 being inserted in the perforations simultaneously is seen in Fig. 3 and described in the first paragraph on page 4 and the paragraph bridging pages 5 and 6.

Appl. No. 09/994,741  
Amdt. dated 1/9/06  
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A typographical error in claim 6 has also been corrected.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph. The above-noted changes to the claims are provided solely for clarification or cosmetic reasons. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

It is appreciatively noted from the Office Action Summary that claims 10-21 have been allowed and from items 3 and 4 on page 3 of the Office action that claims 1-6 and 9 would be allowable if the rejection under 35 U.S.C. § 112 were removed. Since it is believed that the rejection under 35 U.S.C. § 112 has been removed, reconsideration and allowance of claims 1-6 and 9 and the issuance of a Notice of Allowance for claims 1-6 and 9-21 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

Appl. No. 09/994,741  
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If an extension of time is required, petition for extension is herewith made. Any extension fee associated therewith should be charged to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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LAG/am

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